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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,094	12/21/2005	Kazuo Hayashi	58805US004	8134
32692 7590 03/20/2009 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER DESAL, ANISH P				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 03/20/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/562,094

**Applicant(s)**

HAYASHI ET AL.

**Examiner**

ANISH DESAI

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***And DETAILED ACTION***

1. Applicant's arguments in response to the Office action dated 09/09/08 have been fully considered.
2. Support for the amended claims 1-3, 9, 11, and 12 is found in the specification as originally filled.
3. The 35 USC Section 112-second paragraph rejections are withdrawn in view of the present amendment and response.
4. In view of newly added claim 10, a new 35 USC Section 112-first paragraph rejection is made.
5. All of the previously made art rejections are maintained.

***Drawings***

6. The drawings were received on 12/09/08. These drawings are accepted.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. This claim recites that in the ***opaque region*** having ***plurality of discrete transparent regions*** the ***size of the opaque region decreases in the direction towards the transparent region***. The specification does not support this. The specification provides a support for a ***transparent region*** having ***plurality of discrete opaque regions*** wherein the ***size of the opaque regions decreases in the direction towards the transparent region*** (see page 8 lines 4-17 of specification). Accordingly, specification fails to provide the support for claim 10.

#### ***Claim Rejections - 35 USC § 102 or 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 9-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kentaro (JP2002-002192-English translation previously provided by the Examiner).

10. Kentaro teaches a decorative film (equated to Applicant's shading decorative sheet) useful for the interiors of automobiles and buildings (0001, page 4). The decorative film of Kentaro comprises a base layer having a design pattern formed on at least one surface of the base layer wherein the design pattern comprises a plurality of design elements in which at least 50% of the regions have a certain gradation in one or more directions (0004, page 5). Additionally, Kentaro teaches that an adhesive layer can be formed on the decorative layer or on the base sheet.

11. The aforementioned disclosure of Kentaro is interpreted that a shading decorative sheet having a structure of a decorative layer having a gradation pattern at least in one direction/base layer/adhesive layer is contemplated by Kentaro. Moreover, as a base layer, Kentaro discloses the base layer formed of polyvinyl chloride resin, polypropylene resin, polyethylene resin etc. (0026, page 9). It is noted that Applicant's base layer is generally formed of the same material as that of taught by Kentaro (see 0019 of US Patent Application Publication 2007/0116949A1 of the presently claimed invention). Therefore, the base layer of Kentaro is equated to the transparent base layer of the claimed invention.

12. As to the claimed limitations "wherein said gradation pattern comprises..." (claim 1), "wherein the size of the..." (claim 2), "wherein the size of the..." (claim 3), "wherein said gradation pattern comprises..." (claim 9), "wherein the opaque region..." (claim 10), "wherein said gradation pattern comprises..." (claim 11), and "wherein the transparent region..." (claim 12), it is reasonable to presume that said features are necessarily present in the invention of Kentaro.

13. The support for said presumption is based on the following facts:
14. Applicant's decorative sheet has a structure of a transparent base layer having a decorative layer on one surface of the base layer, wherein the decorative layer has a gradation pattern at least in one direction. Further, an adhesive layer is provided on the back surface of the base layer.
15. As set forth above Kentaro teaches a decorative film (equated to Applicant's shading decorative sheet) (0001, page 4). The decorative film of Kentaro comprises a base layer having a design pattern formed on at least one surface of the base layer, wherein the design pattern comprises a plurality of design elements in which at least 50% of the regions have a certain gradation in one or more directions (0004, page 5). Additionally, Kentaro teaches that an adhesive layer can be formed on the decorative layer or on the base sheet.
16. Further, with respect to a method of forming Applicant's decorative layer having gradation, paragraph 0021 of Applicant's US Patent Application Publication 2007/0116949A1, following is disclosed:

**[0021]** The decorative layer 2 is usually formed on the front surface of the thermoplastic resin film using colorants. The decorative layer 2 may be formed on the front surface of the thermoplastic resin film by any of conventional printing methods such as gravure printing, electrostatic printing, electrophotography, screen printing, ink jet printing, offset printing, thermal transferring, etc. The colorants used to form the decorative layer 2 are usually toners or inks.

17. Additionally, Example 1 in the specification discloses use of gravure printing on the front face of a film to create a decorative sheet having a gradation pattern.

18. Kentaro discloses same methods as that of Applicant in forming the decorative layer having a gradation pattern. At paragraph 0027, Kentaro teaches "The decorative layer 3 can have a pattern printed on the front or back side of the base sheet 2...The decorative layer 3 is usually formed as a printed layer...A color ink containing a pigment or dye of the appropriate color can also be used." Further at paragraph 0048, Kentaro teaches "**Methods that can be used for form[ing] the printed layer constituting these decorative patterns include printing methods common in the art such as the offset printing method, gravure printing method, and screen printing method. If a design pattern has gradation of the present invention, the offset printing method and the gravure printing method are especially suitable...**"

19. Based on the aforementioned facts, the decorative sheets of Kentaro and that of Applicant are formed of identical process and have same structure. Therefore, the aforementioned features would necessarily be present. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the shading decorative sheet of Kentaro is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977). Accordingly, Kentaro anticipates or strongly suggests the presently claimed invention.

***Response to Arguments***

20. Applicant's arguments filed on 12/09/08 have been fully considered but they are not persuasive.
21. Applicant argues that Kentaro does not disclose, teach or suggest the gradation pattern as claimed. According to Applicant, "Kentaro uses continuous gradation from opaque to transparent without an opaque region having a plurality of discrete transparent regions adjacent to the opaque region...to the transparent region." (see page 7 of 12/09/08 amendment).
22. The Examiner respectfully disagrees for the following reasons:
23. It is submitted that Applicant's decorative sheet has a structure of a transparent base layer having a decorative layer on one surface of the base layer wherein the decorative layer has a gradation. Further, an adhesive layer is provided on the back surface of the base layer.
24. As set forth above Kentaro teaches a decorative film (equated to Applicant's shading decorative sheet) (0001, page 4). The decorative film of Kentaro comprises a base layer having a design pattern formed on at least one surface of the base layer, wherein the design pattern comprises a plurality of design elements in which at least 50% of the regions have a certain gradation in one or more directions (0004, page 5). Additionally, Kentaro teaches that an adhesive layer can be formed on the decorative layer or on the base sheet.



25. Further, with respect to a method of forming Applicant's decorative layer having gradation, paragraph 0021 of Applicant's US Patent Application Publication 2007/0116949A1, following is disclosed:

[0021] The decorative layer 2 is usually formed on the front surface of the thermoplastic resin film using colorants. The decorative layer 2 may be formed on the front surface of the thermoplastic resin film by any of conventional printing methods such as gravure printing, electrostatic printing, electrophotography, screen printing, ink jet printing, offset printing, thermal transferring, etc. The colorants used to form the decorative layer 2 are usually toners or inks.

26. Additionally, Example 1 in the specification discloses use of gravure printing on the front face of a film to create a decorative sheet having a gradation pattern.

27. Kentaro discloses same methods as that of Applicant in forming the decorative layer having a gradation pattern. At paragraph 0027, Kentaro teaches "The decorative layer 3 can have a pattern printed on the front or back side of the base sheet 2...The decorative layer 3 is usually formed as a printed layer...A color ink containing a pigment or dye of the appropriate color can also be used." Further at paragraph 0048, Kentaro teaches "**Methods that can be used for form[ing] the printed layer constituting these decorative patterns include printing methods common in the art such as the offset printing method, gravure printing method, and screen printing method. If a design pattern has gradation of the present invention, the offset printing method and the gravure printing method are especially suitable...**"

28. Based on the aforementioned facts, the decorative sheets of Kentaro and that of Applicant are formed of identical process and have same structure. Therefore, the aforementioned features would necessarily be present. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the shading decorative sheet of Kentaro is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977). Accordingly, the art rejections are sustained.

### ***Conclusion***

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.
32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./  
Examiner, Art Unit 1794

/Hai Vo/  
Primary Examiner, Art Unit 1794